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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,432	03/08/1999	PHILLIP Y. GOLDMAN	14531.46	3073

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 07/18/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/264,432

Applicant(s)

GOLDMAN ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7,8,14,15,19 and 33-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 June 2003 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-8, 14-15, 19, and 33-42 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's arguments pertaining to claims 1 and 34 that the combined references do not suggest that the "inserted advertisement replaces a preexisting advertisement". The examiner refers the applicant to the Perlman et al. reference which discloses that the embodiment may "overlay advertising over any web page" to ensure that particular advertisements will be viewed regardless of the web site a user visits (Page 18, Lines 11-20). Accordingly, it is the examiner's opinion that this provides would provide the suggestion to one of ordinary skill in the art the ability of the embodiment to "overlay advertising over any web page" which serves to replace a "preexisting advertisement that was included within the information document requested from the server".

Claim Objections

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3. Claim 45 is objected to because of the phrase "is solely used to selecting the advertisement" should be amended to read "is solely used to select[ing] the advertisement". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1, 4-8, 14-15, 19, and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Ballard (US Pat No. 6,182,050), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In reference to claim 1, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an "information retrieval system" such as the WebTV® client terminal [180] (Figure 1B). The client terminal [180] facilitates shared

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screen viewing of television/internet content. Subsequently, it handles both the “request” for and “display” of “information documents” or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the “advertisement repository being stored at the client system” [220] into the retrieved “information documents” and “displayed” [105] (Page 13, Lines 22-28). Furthermore, in one embodiment the “inserted data” or advertisements may replace a “preexisting advertisement that was included within the information document requested from the server” (Page 18, Lines 11-20).

The aforementioned Perlman et al. (WO 98/56128) reference does not explicitly disclose, nor preclude, that the embodiment is operable to “compile a user profile at the client system” (Page 7, Lines 3-10). The Ballard reference discloses an embodiment wherein an “information retrieval system” [14] (Col 5, Lines 41-45, 54-64) may “insert data representing the selected advertisement” based on a “profile of the user of the information retrieval system at the client system” (Col 7, Lines 50-65) which is not “sent to the server computer” [52] for purposes of selecting advertisements to be inserted into information documents which are sent via the server (Col 12, Lines 30-67 – Col 13, Lines 1-41). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Perlman et al. reference, if necessary, to “compile a profile of the user of the information system” as taught by Ballard for the purpose of selecting the most

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relevant advertisements from the Perlman et al. “repository” [220] in a manner that further protects consumer privacy (Ballard: Col 1, Lines 7-60).

The combined Perlman et al. and Ballard references do not explicitly disclose, nor preclude that the “profile includes at least information associated with television programming”. The Ballard reference suggests that the “profile” may monitor “usage” (Col 7, Lines 21-25). The Eldering et al. reference discloses a method for characterizing a subscriber of an “information retrieval system”, such as a PC-TV device, (Col 7, lines 1-12) with information that is “stored locally” (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile may be based “at least information associated with the television programming viewed by the user” (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the “profile” of the combined Ballard and Perlman et al. references, if necessary, with information pertaining to the “television programming viewed by the user” when using a PC-TV as taught by Eldering et al. Such a modification would advantageously enhance the advertisement affinity ranking of Ballard since a “profile” that characterizes a viewer using both viewing and demographic information, subsequently provides additional dimensions to use when targeting advertisements (Eldering et al.: Col 2, Lines 8-11).

Claim 34 is rejected wherein the aforementioned “system” may be implemented using a “computer program product” (Perlman et al.: Page 6, Lines 11-17).

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Claims 4 and 35 are rejected wherein the “act of inserting data representing the selected advertisement is conducted at the client system” (Perlman et al.: Page 18, Lines 11-20; Ballard: Col 13, Lines 4-25).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be “pre-downloaded” and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the “information document” is a web page in HTML format (Perlman et al.: Page 7, Lines 29-31 – Page 8, Lines 1-7).

Claims 8 and 38 are rejected aforementioned wherein the “profile” may be constructed “to further characterize the user” using a combination of user supplied demographic data, and tracking information as illustrated in Figure 1 of the Eldering et al. reference.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including “news” [308] and “reference information related to the content of the television programming” such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be “pushed” to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that “push” technology does not require “direct user assistance”.

Claims 33 and 42 are rejected wherein the compiling of a “profile includes an act of identifying closed captioning received from television programming” (Eldering et al.: Col 5, Lines 36-46).

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Claim 43 is rejected in view of claim 1. With respect to the limitation as to “when” the advertisement is selected, the Ballard reference suggests that the user is sent advertisement target criteria and “prior to requesting the information document, and based at least in part of the profile” the “client system” selects which of these advertisements are to be “stored” in the “advertisement repository at the client system” and subsequently inserted/displayed (Col 12, Lines 41-64). Presumably, the ads to be displayed would be delivered during off-peak hours and stored in a repository as taught by Perlman et al.

As to “when” these ads are selected for insertion, the Ballard et al. reference suggests that the advertisements within the repository comprise playback criteria to determine when an advertisement is “selected” for playback (Col 13, Lines 4-25). For example, the playback criteria might specify that a particular advertisement is to be displayed while the user is on-line at 5:00 PM. Accordingly, “prior to requesting the information document” at 5:00 PM, the “advertisement from an advertisement repository stored at the client system” would have been “selected” for subsequent “insertion” and “display” into the “requested information document” at the specified time.

Alternatively, presuming that the time specifies that the “advertisement” is to be inserted between 5:00 PM and 5:01 PM, the Perlman et al. reference suggests that advertisements may be inserted regardless of the particular web page selected and that advertisers can be certain that its ad is viewed by a viewer, regardless of which web sites they decide to visit (Page 13, Lines 22-28; Page 18, Lines 14-20). Accordingly, the embodiment could feasibly create a “roadblock”, as is known in broadcast television wherein the same commercials are displayed on every channel, such that the “advertisement” selected “prior to” the

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subsequently requested “information documents” would be “inserted” into and “displayed” on every web page that the user visits during that time frame.

Claim 44 is rejected in view of claim 1 wherein the combined Perlman et al., Ballard, and Eldering et al. reference disclose an information retrieval system that compiles a profile of a user including at least television viewing information that is utilized in conjunction with the selecting, insertion, and display of an advertisement in an information retrieval document.

With respect to the limitation pertaining that the selection is “based on a most recently viewed television programming”, the examiner relies on the Ballard reference with respect to the selection of advertisements. The Ballard reference suggests that “usage” information alternatively or in addition to demographic information may be utilized to in conjunction with the selection process (Col 7, Lines 21-25). The Ballard reference does not explicitly state that this “usage” information may further comprise “television viewership” information. The Eldering et al. reference was subsequently relied upon with respect to the teachings pertaining to the inclusion of “viewed television programming”.

The examiner’s interpretation of the claim language is such that the selection only needs to be based on the “most recently viewed television programming”. The Eldering et al. reference suggests that television viewing information would utilize both the “most recently viewed television programming” in addition to past viewing selections in developing the usage profile. Accordingly, when taken in combination with the “selection” teaching of Ballard, the claimed limitation is met such that the selection would be “based on the most recently viewed television programming” in addition to other viewership criteria.

With respect to the limitation of claim 45, as aforementioned the Ballard reference suggests that the “selection” may be based “solely” on “usage” information. The Eldering et al. reference does not preclude that the “information associated with the television programming viewed by the user” is not necessarily “solely” the “most recently viewed television program”. For example, the television viewing information might comprise a single program should the viewer have only watched one program. That program would likewise be the “most recently viewed program”. Accordingly, the Ballard reference “selection” may subsequently be “solely” based on the “most recently viewed program”.

Claim 46 is rejected wherein the Perlman et al. reference suggests that the “inserted data” or advertisements may replace a “preexisting advertisement that was included within the information document requested from the server” (Page 18, Lines 11-20).

Claim 47 is rejected in view of claim 43 wherein the “selected advertisement is selected prior to requesting the information document” such that the advertisements within the “advertisement repository” are further partially “based on a most recently viewed television program”.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

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- The Gupta et al. (US Pat No. 6,487,538) reference discloses a method and apparatus for local advertising wherein local ISPs may replace banner ads with targeted to the user profile information.

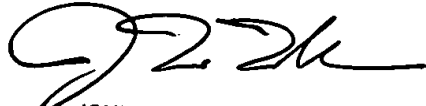
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
July 14, 2003


JOHN MILLER
SUPERVISORY PATENT EXAMINER
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